REMARKS

The applicant requests entry of the amendment of Claims 12 and 15 as noted above in order to correct typographical errors noted by the Applicant therein.

In response to the Examiner's restriction requirement, the applicant confirms the provisional election to prosecute the invention of Group I, claims 1-15.

The Examiner has rejected claims 1-15 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,997,894 to Blum et al. in view of U.S. Patent No. 5,599,375 to Detrick.

The Examiner argues that Blum teaches a process of coating electrical wires with a non-conductive material so that they are protected from animal attacks, and that Blum reads on the applicant's definition of dielectric material. And because Blum teaches that the coating is not only applied to the wire, but to any object subject to attack by animals, one of ordinary skill would recognize that since the wire is subject to attack by animals, the structure supporting the wire would be as well. Therefore it would be obvious to coat the structure supporting the wire with the coating of Blum as well as the wire.

The Examiner further argues that Blum also teaches that the composition is mostly comprised of wax and/or oil being mixed with polymers and is applied by methods known in the art. However, Detrick teaches that it is known to apply coatings of polymeric hydrocarbons, petroleum-based wax, or combinations of high viscosity polymeric paraffinic oil plus polyethylene by converting the material into a hot melt and spraying it on the substrate. Therefore, the Examiner asserts, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to apply the coating of Blum by the spray method of Detrick.

Applicant respectfully submits that claims 1-15 are allowable as currently on file and that the rejection of the Examiner is overcome by the remarks that follow.

Firstly, Applicant submits that Detrick may not be applied in the manner suggested by the Examiner because it is nonanalogous art. Detrick is from a diverse field of art that is remote from the claimed invention such that a person of ordinary skill in the claimed art would not look to Detrick to solve the problem treated by the claimed invention - *In re Pagliaro*, 657 F.2d 1219, 210 USPQ 888 (CCPA 1981). In *In re Winslow*, 151 USPQ 48 (CCPA 1966), the court stated that:

> Section 103 requires us to presume full knowledge by the inventor of the prior art in the field of his endeavor ... but it does not require us to presume full knowledge by the inventor of prior art outside the field of his endeavour, i.e., "nonanalogous" art.

In the present case, Detrick is directed to a process for producing sulfur-coated urea, slow release granular fertilizers, and is classified under U.S. class 71 for chemical fertilizers. In contrast, the claimed invention is directed to methods for resisting electrical shorts caused by an animal contacting an electrified wire and a structure supporting the wire, and is classified under U.S. class 427 for coating processes. It is respectfully submitted that Detrick is in a field of art that is neither in the field of technology of the claimed invention, nor deals with the same problem solved by the claimed invention. A person of ordinary skill in the art would not look within the chemical fertilizer art for a solution on preventing electrical shorts in electrified wires due to animals. Accordingly, it is respectfully submitted that Detrick may not be applied as a reference by the Examiner to establish a prima facie case of obviousness.

Additionally, a prima facie case for obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination - *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). In *In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278 (Fed. Cir. 1987) the court stated that "[t]he mere fact that references can be combined or modified does not render the resultant combination

obvious, unless the prior art also suggests the desirability of the combination." One must be able to point to something in the prior art that suggests in some way a modification of a particular reference or a combination with another reference in order to arrive at the claimed invention. Applicant respectfully submits that neither Blum nor Detrick teaches or suggests a combination with, or modification of, the other reference.

Furthermore, Applicant submits that the cited references, alone or in combination, do not teach or suggest the elements of the claimed inventions in any of the independent claims 1, 8 and 15. As discussed above, Detrick is nonanalogous art, whereas Blum addresses the problem of damage caused by animal attacks (such as rodents) directly on cables, wires, etc. The problem to be solved in Blum is providing a coating that is resistant to an animal attack up to the biting power of squirrels of 22,000 psi. In contrast, the present invention is directed to providing methods for resisting electrical shorts caused by animals in high voltage, electricity transmission lines. There is no teaching or suggestion in Blum that would lead a person of ordinary skill in the art to apply the compositions disclosed in Blum on high voltage, transmission lines.

Accordingly, Applicant submits that independent claims 1, 8 and 15 are not obvious over the cited references. Claims 2-7 and 9-14 derive patentability from their direct or indirect dependence on claims 1 and 8 respectively.

Accordingly, Applicant submits that the Examiner has failed to establish prima facie obviousness for claims 1-15. Applicant submits that claims 1-15 in the application are in condition for allowance. Reconsideration and allowance of claims 1-15 are requested.

Respectfully submitted,
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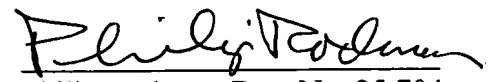

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